

ESTTA Tracking number: **ESTTA526620**Filing date: **03/13/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Rita M. Clark d/b/a Bluewater Rentals
Granted to Date of previous extension	03/13/2013
Address	21092 First Avenue East Cudjoe Gardens, FL 33042 UNITED STATES
Attorney information	Michael N. De Biase, Esq. Becker & Poliakoff, P.A. 3111 Stirling Rd. Ft. Lauderdale, FL 33312 UNITED STATES mdebiase@becker-poliakoff.com Phone:(954) 985-4145

Applicant Information

Application No	85644802	Publication date	11/13/2012
Opposition Filing Date	03/13/2013	Opposition Period Ends	03/13/2013
Applicant	BLUEWATER KEY RV OWNERSHIP PARK PROPERTY OWNERS ASSOCIATION INC. 2950 US HIGHWAY 1 KEY WEST, FL 33040 UNITED STATES		

Goods/Services Affected by Opposition


Class 043. First Use: 1989/00/00 First Use In Commerce: 1989/00/00
All goods and services in the class are opposed, namely: RV resort rental services, namely, recreational vehicle (RV) park services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4274836	Application Date	05/13/2012
Registration Date	01/15/2013	Foreign Priority Date	NONE
Word Mark	BLUEWATER RENTALS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2002/11/01 First Use In Commerce: 2002/12/01 Arranging of leases and rental agreements for real estate

Attachments	85623894#TMSN.jpeg (1 page)(bytes) Bluewater Rentals - Notice of Opposition v Bluewater Key.pdf (16 pages)(790491 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/michael n debiase/
Name	Michael N. De Biase, Esq.
Date	03/13/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85644802
Published in the Official Gazette on November 13, 2012
Mark: Bluewater Key
International Class: 43

CLARK, RITA M. d/b/a
BLUEWATER RENTALS

Opposer,

Opposition No. _____

v.

BLUEWATER KEY RV OWNERSHIP
PARK PROPERTY OWNERS
ASSOCIATION, INC.,

Applicant.

_____ /

NOTICE OF OPPOSITION

Opposer, Rita M. Clark, d/b/a Bluewater Rentals ("Opposer") believes that she will be damaged by the registration of the mark "Bluewater Key" (the "Subject Mark") for recreational vehicle ("RV") resort rental services, namely, RV park services in International Class 43, as shown in the application referenced above, Serial No. 85644802 (the "Application"), and hereby opposes the same pursuant to Section 13(a) of the Lanham Act, codified at 15 U.S.C. § 1063(a).

As grounds for the opposition, Opposer alleges that:

1. Opposer is a sole proprietorship maintaining an address for correspondence at 21092 First Avenue East, Cudjoe Gardens, Florida 33042.
2. Opposer has used "Bluewater Rentals", "Bluewater Key", and other variations of marks containing the term "Bluewater" (collectively, the "Bluewater Marks") in commerce in

the United States in connection with arranging for lease and rental agreements for real estate, including RV lot resort rentals, since January, 1999.

3. In addition to the aforementioned common law rights, Opposer currently has a registered federal trademark, Registration No. 4274836 for BLUEWATER RENTALS for "arranging of leases and rental agreements for real estate" in International Class 36, registered on January 15, 2013 based on use and use in commerce since December, 2002. A copy of Opposer's registration certificate is attached as Exhibit "A".

4. There is no issue as to priority. Opposer's use of the Bluewater Marks predates the use of the Subject Mark by Applicant in connection with Applicant's RV resort rental services. Moreover, Applicant's use of the Subject Mark is made in connection with services identical or nearly identical to those offered by Opposer in connection with its Bluewater Marks.

5. During its continuous use of the Bluewater Marks over the past fourteen (14) years, Opposer has expended considerable amounts of time, energy, and money in marketing, advertising, and publicizing its rental and leasing services. Opposer has built a strong reputation and considerable goodwill within the RV community.

6. Opposer has marketed and sold its rental and leasing services throughout the United States, and continues to provide its services to consumers, throughout the United States, largely via its website <bluewaterkey.net>.

7. Upon information and belief, Applicant is a Florida non profit corporation with a principal address of 2950 US Highway 1, Key West, Florida 33040.

8. Applicant conducts its real estate related affairs in a manner consistent with a homeowner's association, but due to the fact that the subject real estate within Applicant's

association is comprised of RV lots instead of homes, Applicant refers to itself as a “property owner’s association.”

9. By its Application, Applicant seeks to register the term “Bluewater Key” for “RV resort rental services, namely, RV park services” in International Class 43.

10. The Application contains false and material misrepresentations, which Applicant made with the intent to deceive the United States Patent and Trademark Office (“USPTO”).

11. The Application materially misrepresents the services provided in connection with the Subject Mark as being within International Class 43, despite these services being more akin to those within International Class 36. To wit, the Nice Agreement Tenth Edition – General Remarks, Class Headings and Explanatory Notes – Version 2012, describes services in International Class 43 as relating to “services for providing food and drink; temporary accommodations” and specifically excludes “rental services for real estate... (Cl. 36)”; whereas, services in International Class 36 are described as relating to “insurance, financial affairs, monetary affairs, and real estate affairs.”

12. Applicant’s business activities involve the activities customary to community or homeowner’s associations; e.g. maintenance and preservation of common areas, collecting fees, and representing the general interests of the members of the association – the property owners. Contrary to the Application, Applicant’s activities substantially differ from those offered by a hotel or similar type of temporary lodging facility.

13. Upon information and belief, Applicant intentionally made false and material misrepresentations concerning the services it provides in connection with the Subject Mark in furtherance of avoiding USPTO Examining Attorney scrutiny, including potential office actions, and procuring a trademark registration for the Subject Mark.

14. By its Application, Applicant claims to have provided RV resort rental services under the Subject Mark since 1989. However, communications between Applicant and its members, as well as internal association documents, establish that Applicant did not contemplate, and eventually begin, providing RV lot rental services until April 15, 1999 - ten years later. See Composite Exhibit "B".

15. Applicant was formed and incorporated in 1989 by the developer of the Bluewater Key RV Lot Resort. From its inception until January, 1999, Applicant was operated by the developer.

16. Prior to April 15, 1999, the RV lot owners comprising the association rented their lots on their own, or through a separate and independent entity owned and operated by the developer's daughter Catherine Good Duncan. This entity had an agreement with Applicant for the rental of the RV lots (the "Agreement").

17. In January of 1999, when the members took control of Applicant's board, the board began contemplating the termination of the Agreement, and later that year, on April 15, terminated the Agreement leaving Applicant to handle the rental business of the RV lots. At this time, Applicant first used the Subject Mark in commerce in connection with "RV resort rental services."

18. When Applicant commenced its rental business, it possessed indisputable knowledge of Opposer's use of the Bluewater Marks in connection with the provision of Opposer's leasing and rental services.

19. Applicant knew of Opposer's use of the Bluewater Marks when it submitted the Application.

20. Upon information and belief, Applicant intentionally submitted the Application with a false and misleading representation as to the Subject Mark's date of first use in commerce, in an attempt to wrongfully establish priority over Opposer's Bluewater Marks, and deceive the USPTO to obtain a trademark registration for the Subject Mark.

21. Registration of the Subject Mark should be refused and the Application herein should be terminated on the grounds that Applicant knowingly made false and material representations with the intention to deceive the USPTO.

22. Additionally, Applicant's Subject Mark is confusingly similar to Opposer's Bluewater Marks. Both the Bluewater Marks and the Subject Mark contain the term "Bluewater" as their strongest and defining element. As a whole, these marks are nearly identical in sight, sound, and commercial impression

23. The services marketed and sold in connection with Applicant's marks; specifically, the "RV resort rental services," are nearly identical to the services marketed and sold in connection with Opposer's Bluewater Marks.

24. Both Opposer and Applicant provide services for the leasing and renting of RV lots within the same RV resort, Bluewater Key RV Resort.

25. Both Opposer and Applicant market their services through the same channels, and to the same target market; namely, internet advertisement and periodicals aimed at RV owners and renters of Florida vacation property.

26. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of the Subject Mark, and will give color or exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

27. Registration of the Subject Mark should be refused pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the grounds that Applicant's BLUEWATER KEY mark so closely resembles Opposer's BLUEWATER RENTALS mark and Bluewater Marks, as to be likely to cause confusion or deception to the consuming public, in addition to injuring Opposer.

WHEREFORE, Opposer believes it will be damaged by the registration of Applicant's BLUEWATER KEY mark for the services identified in the Application, and respectfully requests that the opposition be sustained and registration of the Subject Mark be denied.

Pursuant to 37 C.F.R. § 2.6(a)(17), Opposer submits the \$300 statutory filing fee for filing a Notice of Opposition in one international class herewith.

All communication should be addressed to Opposer's counsel at the below stated address, attention Michael N. De Biase, Esq..

/s/ Dated: March 13, 2012

Respectfully submitted,

/s/ Kevin Markow

KEVIN MARKOW, ESQ.

Florida Bar No. 66982

MICHAEL DE BIASE, ESQ.

Florida Bar No. 076205

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Attorneys for Applicant

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on March 13, 2013, the undersigned electronically filed this document with the Trademark Trial and Appeal Board, and has caused a true and correct copy of this Notice of Opposition to be served via email and first class mail, postage prepaid, to:

Arlen Olsen
Schmeiser, Olsen & Watts, LLP
22 Century Hill Drive, Suite 302
Latham, NY 12110
aolsen@iplawusa.com

with a hard copy only (no email) to:

Bluewater Key RV Ownership Park
Property Owners Association, Inc.
2950 US Highway 1
Key West, Florida 33040

/s/ Kevin Markow
KEVIN MARKOW, ESQ.

ACTIVE: C11386/335068:4391392_1

EXHIBIT "A"

United States of America

United States Patent and Trademark Office

Bluewater Rentals

Reg. No. 4,274,836

Registered Jan. 15, 2013

Int. Cl.: 36

SERVICE MARK

PRINCIPAL REGISTER

CLARK, RITA M. (FLORIDA SOLE PROPRIETORSHIP), DBA BLUEWATER RENTALS
121 DROST DRIVE
CUDJOE GARDENS, FL 33042

FOR: ARRANGING OF LEASES AND RENTAL AGREEMENTS FOR REAL ESTATE, IN
CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 11-1-2002; IN COMMERCE 12-1-2002.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PAR-
TICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "RENTALS", APART FROM
THE MARK AS SHOWN.

SER. NO. 85-623,894, FILED 5-13-2012.

MICHELLE DUBOIS, EXAMINING ATTORNEY



David J. Kybas

Director of the United States Patent and Trademark Office

EXHIBIT "B"

Minutes of the Annual Meeting of the Owners of Bluewater Recreational Vehicle Park

Thursday January 21, 1999

James Mazurek lot 77 called the meeting to order and introduced the officers.

Wayne Wuerl lot 66 gave the following financial report.

1/21/99 Treasures Report

As of 1/21/99 the association bank balance is \$61,755.86

Outstanding association dues are \$6,804.92. Of the outstanding dues Saddle RV Park (Lloyd Good) is owed \$802.03 for funds extended during the period 11/06/98 to 12/30/98.

Available outstanding funds when all dues are collected will be \$67,622.88 and should be sufficient for 1999.

Notice is given that as of February 5, 1999 outstanding assessments will be deemed delinquent, subject to section 8 of the declaration of restrictions and protective covenants for Bluewater Key RV Park. That is there will be a late fee of \$25.00 per lot imposed and interest at prime currently (7.75%) + 2% will begin to accrue.

Association members can expect dues notices to be mailed to the address of record maintained by the association on approximately 10/01/99 and 10/1 of each succeeding year. Dues are payable at that time. Dues will become delinquent effective 1/01/2000 and 1/1 of each succeeding year.

Delinquent association members will be published.

Delinquent dues will be offset from any available rent.

It should be fairly plain that dues are and have been a problem. I appeal to your sense of fairness to your fellow lot owners to pay your dues promptly.

For those association members who rent their lots, it should be noted and understood Section 14 prohibits direct leasing by an owner. All rentals must be made through the proper association representative.

Dave Goodrich lot 38 asked who the board was and who had voted it in. James Mazurek answered that we had been elected by a 3/4 vote of the owners. Dave Goodrich stated that he had not received any ballot material even though it was sent to the same address as his rent.

Bob Dagenhart lot 35 made the motion and it was seconded that the board be accepted and that we move on.

Bob Dagenhart asked how we intended to handle the rental function. Katherine Duncan's contract was discussed. No conclusions were reached.

Ed Frisbee lot asked if the rental business and the regular park operations were to be combined. Wayne Wuerl answered that the board had the power to combine the operations and that it intended in doing same. Mr. Frisbee stated that he was not in favor of the combination of the two businesses.

Dave Goodrich wanted to know how the checkbook was handled, and how many signatures were required to write a check. Jim answered him that only two signatures were needed to write a check. A motion was made by Bob Dagenhart that the treasurer's report be accepted, Roland Clark lots 1,2,3,15,16 seconded the motion.

A compiled list of the owner's concerns was distributed. Jim Mazurek explained that the board was trying to handle as many of the items on the list as possible but they currently were working on the major issues of the purchase of Lots C & D and the replacement of the gates.

Jim Mazurek announced that the next annual meeting of the owners would be held on the third Thursday of January 2000, at 10:00 AM.

Jim Mazurek stated that he would be the contact person for complaints to the board and that he preferred that the comments be in writing and placed in his mail box, and that a suggestion box was going to be installed in the laundry.

Jim Mazurek explained that the board had been made aware of the large number of nuisance complaints. He asked that all the owners work together to try to control this sort of thing.

Jim Mazurek stated that we were working on a new owner's directory and that a questionnaire would be mailed.

Rita Clark lots 1,2,3,15,16 suggested that we include E mail addresses in the new owner's directory.

Ron LaCroix lot 43 asked the board what there plans were for storage trailers, if the board intended to stop future trailers and grandfather in the existing. He felt that would be unfair. Jim stated that the issue was under consideration, but as of now no conclusions had been reached.

Dick Nageotte lot 53 stated that personal responsibility was the answer to a lot of concerns and that each of us need to govern our actions by the common good.

Jim Mazurek stated that the park would officially start picking up waste vegetation if it was in normal amounts. Waste vegetation from a "landscaping event" would have to be removed at the owner's expense.

Jim Mazurek explained that the board was aware of the need for some park signs and that we were looking into the matter.

Jim Mazurek explained that we were trying to get two committees functional. One being the Capital Improvements Committee, the other being the Landscape Committee. Volunteers were asked for.

Dick Nageotte talked about the purchase of tracts C & D. That purchased or not, we get the sewage plant and access to same. He explained that there was a limited amount of legal uses for development of C & D. He explained that there would have to be a variance to put up a hotel. He stated that a lot of work would be required to get the easements in order however. Rita Clark stated that she had copies of some of the contested recordings. Richard stated that he had not found these during his search. Richard explained the importance of getting and keeping the sewer plant in compliance. He stated that in his option with the exception of the tenant on lot D he would go ahead with the deal. Rita Clark asked if that was a legal option and Richard stated that it was simply the opinion of one owner to another.

Kim Cole lot 78 asked about notices of future park changes. Jim stated that in the near future everyone would be getting a copy of the minutes of this meeting, the park insurance policy and or first news letter.

Sandy Fredricks lot 13 asked whether there will be any more meetings this year. Wayne Wuerl replied that this meeting fulfilled the covanance requirements and that there would be no more meetings this year.

Jerry Spivak a renter on lot 1 stated that he wanted to publicly thank Ed Frisbee lot 39 for his efforts in organizing the cleanup details in the park.

Roland Clark stated that he wanted to thank John Simpson for his efforts at cleaning up after hurricane George.

Ed Frisby made the motion that the meeting be adjourned, it was seconded by Bob Daggenhart and passed.

ROLAND B. CLARK, MD

January 23, 1999

Mr. Jim Mazurek, President
Owners Association, Bluewater Key RV Resort
Copies: Board of Directors

Dear Jim:

To begin with, I would like to express my appreciation to you and all the members of the Board of Directors for your willingness to take on the job of running our organization. ~~In my view your job should be enjoyable, and I'll do what I can to make it as painless as possible.~~

The following are some of my comments :

1. Communication, voting, and decision-making

At the conclusion of our first Association meeting there were still several unanswered questions. We need a process to come to closure on items such as these, both now and in the future. I propose that polling the membership directly or by telephone would be the quickest and most efficient approach. A written ballot would need to be sent to those members not in the park or unavailable by phone. At times not every member will respond or be available, and in that event the same rules that govern proxies and quorum for the membership meeting should apply to the polling process.

2. Purchase of lots C and D

I feel strongly that the Association should purchase C and D promptly. Mr. Good has placed, as a condition of sale, a five year access condition to a small portion of one of these lots. They are his lots, and I believe he is free to place any conditions he chooses on their sale. Furthermore, he is under no obligation to sell these lots to the Association. Purchase of the lots by the Association would serve to protect the park from undesirable development. Finally, his retention of access in no way interferes with the appearance or operation of the park.

3. Rentals and control of rentals

Under our current arrangement the Developer, and now the Association, has contracted with an individual who manages the rental of lots. That individual collects the rent monies, retains twenty percent of the rental amount for short term rentals, and ten percent for long term rentals. That individual then pays the on-site manager a portion of the commission for services the on-site manager performs. The remaining balance is forwarded to the owner of the lot.

The current plan calls for the termination of the contract with the rental agent on April 15, 1999. The Association would then assume the responsibility for the rentals.

The Association business plan for the management of rental services should be founded on the principle that the costs of providing rental services should be borne by those lot owners who rent out their lots. Those costs should continue to be deducted from the rental income in the form of a commission, just as we do currently. I propose that the Association determine the actual cost of providing rental services to short term and long-term renters. Those costs should then be deducted from the rents. The actual costs would no doubt include, but not be limited to, marketing, the labor of booking lots, collecting rent monies, and a portion of the cost of maintaining the "800" number.

4. On-site manager

As you know, Mrs. Bea Underwood currently serves as our on-site manager. She has proved to be a loyal and trusted friend to the park and the Association. Guests and owners alike find her helpful, patient, and available. With good communication with the governing board she would serve the Association well. I believe she has earned the chance to show us what she can do.

Thanks again for your efforts on our behalf.

Bluewater Key

AN RV OWNERSHIP PARK



2950 US Highway 1, Key West, FL 33040

1-800-237-2266 305-745-2494 FAX 305-745-2433

www.bluewaterkey.com E-Mail: bluekeyrv@aol.com

September 9, 1999

"PRESIDENT'S NEWSLETTER"

Friends and Neighbors,

What a beautiful fall we are having in Michigan! We recently made a trip though Ohio and Kentucky and the fall colors in those states were also nearing their peak. So get out here and enjoy the great color show put on by Mother Nature. Now is the time to go for it. Today will be just a memory tomorrow. . . make it a good one!

Onward to the subject of our Park and what's been accomplished by your board members and neighbors since January, 1999.

Our first project was the purchase of lots "C & D" from Llyod. Some said it was a bargain, and some people felt that Llyod should have given us the property. I personally feel that it's a great asset for us to own it when you consider the problems that ownership of the lots will save us in the future.

We just recently purchased Llyod's rights to use Lot "C" and we got rid of his tenant problem forever! That cost us \$5,000, but it will save us that much in utilities over the coming years and more problems with Lyodd's tenants.

Our next move was the negotiation with Llyod's Daughter's corporation to turn the rentals over to the park. This resulted in the hiring of Bee Underwood as a Rental Agent and as our Park Manager.

Onward to the next project which was to find a way to improve the entrance. RVs were constantly running into our gates, resulting in damages to the RVs and the gate. I'd like to thank all of you who helped solve this problem, board members and lot owner's who worked together.

All owners can purchase a gate opener at the office.

We also installed a new sign near the highway. The sign is an aid in several ways.

I made a survey of seven RV ownership parks to compare operational costs. We are the smallest park in this survey. The next smallest park had 170 lots and the largest park exceeded 400 lots. We need all the same services that all the larger parks require. We must have a secret because our operational cost, are less than all the parks that I surveyed. I believe that our secret comes from a team effort of all those owner's and board member's who gave so freely of their time, talent, tools, and muscle. I thank you all for helping make our park the "Best Park in the Key's".

There is still a lot to do. We can discuss future projects at our next general meeting on January 18, 2000 at 10A.M. Our new board will be introduced at the meeting and will take over at the conclusion of the meeting. Please return your vote A.S.A.P.

If anyone else would like to serve on the board please contact Tim Appert at the Park so that your name will be included in the requests for Votes by November 15th.

You will be receiving a list of prospective board members with a request for your vote in the mail soon.

Votes must be returned by January 1, 2000.

I wish you all a Safe, Happy, and Healthful return to our park.

Sincerely,



Jim Mazurek

President of the Board